

REMARKS

The Applicant thanks the Examiner for a very thorough examination of the patent application. In the Office Action Claims 3, 5, 9 and 11-14 are objected to as being dependent on canceled Claims. Claims 3, 5, 9 and 11-14 have been cancelled. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being un-patentable over US Patent Number 5,624,049 issued to Kovash et al. in view of US Patent Number 6,234,371 issued to Sinn, US Patent Number 3,724,713 issued to Coren and US Patent Number 5,735,639 issued to Payne.

BRIEF REVIEW OF THE CLAIMED INVENTION

The Claimed invention is a storage device for ladders. The storage device has a substantially rectangular bottom wall with a plurality of apertures adjacently spaced to the perimeter edges of the bottom wall's two long sides. The apertures are positioned in the bottom wall from top to bottom i.e., the apertures extend through the bottom wall, Fig. 1c.

A first substantially rectangular sidewall is perpendicularly spaced along the substantially rectangular bottom wall's apertures parallel to the substantially rectangular bottom wall's long side perimeter edge thereby forming a flange between the bottom wall and the sidewall, Fig. 1c and 1b. A second substantially rectangular sidewall is perpendicularly spaced along the substantially rectangular bottom wall's apertures parallel to the substantially rectangular bottom wall's other

long side perimeter edge thereby forming a flange between the bottom wall and the sidewall, Figs. 1c and 1b.

A substantially rectangular front wall has one long perimeter edge connected to one of the substantially rectangular bottom wall's short sides. The substantially rectangular front wall is angularly positioned towards the substantially rectangular bottom wall's other short side. The substantially rectangular front wall is mounted to one short side of the first and second substantially rectangular sidewalls.

A substantially rectangular top wall is connected to the front wall, the first substantially rectangular sidewall and the second substantially rectangular sidewall. A substantially rectangular rear wall is oppositely spaced from the substantially rectangular front wall. The substantially rectangular rear wall has one long side hinged to the substantially rectangular top wall. The substantially rectangular rear wall's other long side is detachably secured to the substantially rectangular bottom wall.

THE CITED KOVASH ET AL. PATENT

The Kovash et al. patent discloses an elongated rectangular container used for shipping, Fig. 1. The container body i.e., the top, side and bottom walls are made from a single piece of metal. The top wall has a radius bend connecting the top wall to the sidewalls. The sidewalls have a radius bend connecting each sidewall to the bottom wall. Four corner fittings are aligned and connected to the

radius bend of the bottom and top sidewalls. The four corner fittings extend outward from the sidewalls. The container has a sealed rear wall. The other end of the container is open. The open end has a hinged door connected to the top wall. The four corner fittings are designed for hoisting and securing the container to a rail car and the like.

THE CITED SINN PATENT

The Sinn patent discloses a luggage box that has a rigid bottom shell that can be secured on transverse supporting posts. A top shell mounted to the bottom shell can swivel open. The top shell may, if desired, be removed from the bottom portion and used as boat. To accomplish this alternate use, Sinn has included a keel mounted on the bottom shell and positioned from curved bow to stern. The curved bow portion is presumed to be contoured from each sidewall or gun-wall portions to the keel to facilitate the use as a boat.

THE CITED PAYNE ET AL. PATENT

The Payne et al. patent discloses a mobile safety structure for storing and handling containers of hazardous materials. The container is rectangular in shape and has four corner locking devices to allow stacking of the container.

THE CITED COREN PATENT

The Coren patent discloses a rectangular container with ribbed side and top support. The container has a door at one end and the front portion of the container is sloped. It appears to be ground mounted and is not stackable.

5 COMPARISON OF THE CLAIMED INVENTION TO THE KOVASH ET AL. PATENT

Independent Claim 15 recites, in part, a storage device comprising a rectangular bottom wall with a plurality of apertures adjacently spaced to the perimeter edges of the bottom wall's two long sides. A first substantially rectangular sidewall is
10 perpendicularly spaced along the substantially rectangular bottom wall's apertures parallel to the substantially rectangular bottom wall's long side perimeter edge. A second substantially rectangular sidewall is perpendicularly spaced along the substantially rectangular bottom wall's apertures parallel to the substantially rectangular bottom wall's other long side perimeter edge.

15 The Kovash et al. patent teaches that sidewalls should have a radius bend with the bottom and top walls of the container. The Claimed invention has a perpendicular connection between the bottom, top and sidewalls. In this respect, the Kovash et al. patent teaches away from the claimed invention. Further, the Kovash et al. patent teaches the four corner fittings extend outward from the sidewalls and there is not
20 a plurality of apertures adjacently spaced to the perimeter edges of the bottom

wall's two long sides. The Claimed invention has no such limitations.

COMPARISON OF THE CLAIMED INVENTION TO THE SINN PATENT

The Sinn patent teaches a top shell may, if desired, be removed from the bottom
5 portion and used for a boat. To accomplish this alternate use, Sinn has included a
keel mounted on the bottom shell positioned from curved bow to stern. The curved
bow portion is presumed to be contoured from each sidewall or gun-wall portion to
the keel to facilitate the use as a boat. The Claimed invention has no keel and its
front sloped portion is not contoured.

10 COMPARISON OF THE CLAIMED INVENTION TO THE KOVASH ET AL. PATENT IN VIEW OF THE SINN, PAYNE ET AL. AND COREN PATENTS

The Kovash et al. in view of the Sinn, Payne et al. and Coren patents patent suffers
from the same deficiencies as the Kovash et al, Sinn, Payne et al. and Coren
15 patents taken individually. The Applicant respectfully reminds the Examiner that
to establish a *prima facie* case of obviousness, three basic criteria must be met.
First, there must be some suggestion or motivation, either in the cited references
themselves or in knowledge generally available to one of ordinary skill in the art, to
modify the references or combine reference teachings. Second, there must be a
20 reasonable expectation of success. Finally, the prior art reference must teach or

suggest all the Claimed limitations.

The teachings or suggestions to make the Claimed combination and the reasonable expectation of success must be found in the prior art not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)
5 and MPEP 706.02 (j).

The references of record simply do not teach, suggest or disclose the presently Claimed invention, either individually or in combination. It is respectfully submitted that the Examiner has not established a case of *prima facie* obviousness and is using hindsight contrary to the mandate of the Court of Appeals for the
10 Federal Circuit in making a § 103 rejection. The Courts have held in all determinations under 35 USC § 103 that the decision maker must bring judgment to bear. It is *impermissible*, however, to engage in a hindsight reconstruction of the Claimed invention using the Applicant's methodology as a template and selecting steps from references to fill the gaps.

15 Most recently the Court of Appeals for the Federal Circuit (CAFC) has ruled that a critical suggestion to modify the prior art to arrive at a Claim must be supported by some evidence in the prior art references *In re Dembicazak*, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). This ruling by the CAFC is not new; the Courts have consistently ruled an explicit teaching must be delineated in the prior
20 art references.

In this instance, the references relied upon by the Examiner taken

individually or collectively, without the benefit of hindsight vision afforded by the Applicant's disclosure, do not disclose or suggest the Claimed invention.

In view of the foregoing Amendment to the Claims and associated remarks, Applicant respectfully requests the Examiner pass this case to issue. If, in the
5 opinion of the Examiner, a telephone conference would expedite the issuance of this application, the Examiner is invited to call the undersigned Agent.

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Respectfully submitted,

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